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| APPLICATION NO.        | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------|-------------|----------------------|---------------------|------------------|
| 09/973,354             | 10/09/2001  | Sandro D. Klein      | 81230.21US2         | 5285             |
| 34018                  | 7590        | 05/20/2004           | EXAMINER            |                  |
| GREENBERG TRAURIG, LLP |             |                      | SHANKAR, VIJAY      |                  |
| 77 WEST WACKER DRIVE   |             |                      | ART UNIT            |                  |
| SUITE 2500             |             |                      | PAPER NUMBER        |                  |
| CHICAGO, IL 60601-1732 |             |                      | 2673                | 7                |

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/973,354

Applicant(s)

KLEIN ET AL.

Examiner

VIJAY SHANKAR

Art Unit

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 16-28 and 34-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 29-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2,3,4</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15 and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wharton et al (5,831,664 provided in PTO-1449) in view of Treyz et al (6,587,835)

Regarding Claims 1, 29, Wharton et al teaches a communication system, comprising: a hand-held wireless controller (12 in fig.1, 3a-3f) having a display (Figs.1,3; Col.3, line 55- col.4, line 65), the hand-held wireless controller operable to transmit command codes to control the operation of a first consumer electronic device (14 in fig.1; see Figs. 1-2, 4-7; Col.3, line 25- col.4, line 28; Col.6, line 19- col.7, line 32) and to receive data to be printed from a second consumer electronic device (16 in fig.1) and to display a representation of the data to be printed in the display (Figs.1-9; Col.3, line 26- col.4, line 27; Col.6, line 19- col.7, line 32).

However, Wharton et al does not teach a base station adapted to receive communications from the wireless controller including the data to be printed; and a printer coupled to the base station for use in creating a print output based on the data to be printed.

Treyz et al teaches the handheld wireless device comprising a base station adapted to receive communications from the wireless controller including the data to be printed (Figs.1-2,4,6, 18-19;21, 92,99,100, 107,116); and a printer coupled to the base station for use in creating a print output based on the data to be printed (Figs.1-2,4,6, 18-19;21, 92,99,100, 107,116; Col.9, line 56- col.12, line 55; Col.15, line 3- col.16, line 55; Col.23, line 26- col.24, line 53; col. 53, line 45- col. 54, line 22).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Treyz into Wharton et al for printing the display data or coupon from the hand-held wireless device for providing more user friendly the hand-held wireless device .

Regarding Claim 2, Wharton et al teaches the communication system wherein the first consumer electronic device and the second consumer electronic device are the same consumer electronic device (see Figs.1-2).

Regarding Claim 3, Wharton et al teaches the communication system wherein the first consumer electronic device comprises a television (14 in fig.2) and the second consumer electronic device comprises a set-top box (16 in fig.1).

Regarding Claim 4, Wharton et al teaches the communication system wherein the first consumer electronic device comprises a television (14 in fig.2) and the second consumer electronic device comprises a personal computer (fig.1; col.3, lines 36-37).

Regarding Claims 5-7, Treyz et al teaches the communication system wherein the hand-held wireless controller and the base station have cooperating contacts for removably coupling the wireless controller to the base station; and the hand-held wireless controller comprises a power source and wherein the base station is adapted to recharge the power source when the hand-held wireless controller is coupled to the base station; and wherein the hand-held wireless controller and the base station communicate using RF transmissions (Figs.1-2,4,6, 18-19;21, 92,99,100, 107,116; COL.9, line 56- col.12, line 55; Col.15, line 3- col.16, line 55; Col.23, line 26- col.24, line 53; col. 53, line 45- col. 54, line 22).

Regarding Claim 8, and 12-15, Treyz et al teaches the communication system further comprising a personal computer which provides server functionality coupled to the base station for receiving from the base station data transmitted from the wireless controller and wherein the base station comprises a controller for directing data to the printer or to the personal computer; and the personal computer and the base station are adapted to communicate using serial transmissions; the printer is integral with the base station; the data to be printed comprises data representative of a bar code; the printer comprises programming for printing industry standard formatted bar codes (Figs.1-2,4,6, 18-19;21, 92,99,100, 107,116; COI.9, line 56- col.12, line 55; Col.15, line 3- col.16, line 55; Col.23, line 26- col.24, line 53; col. 53, line 45- col. 54, line 22).

Regarding Claim 9, Wharton et al teaches the communication system further comprising a set-top box which provides server functionality coupled to the base station for receiving from the base station data transmitted from the wireless controller and wherein the base station comprises a controller for directing data to the printer or to the set-top box (Figs.1-2; Col.3, line 26- col. 4, line 27).

Regarding Claim 10, Treyz et al teaches the communication system further comprising a Web-enabled game console which provides server functionality coupled to the base station for receiving from the base station data transmitted from the wireless controller and wherein the base station comprises a controller for directing data to the printer or to the Web-enabled game console (Figs.1-2,4,6, 18-19;21; 100, 107,116; Col.9, line 56- col.12, line 55; Col.15, line 3- col.16, line 55; Col.23, line 26- col.24, line 53; col. 53, line 45- col. 54, line 22; col.58, line 37- col.59, line 65).

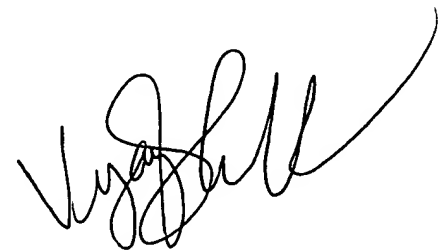
Regarding Claim 11, Wharton et al teaches the communication system further comprising a home gateway box which provides server functionality coupled to the base station for receiving from the base station data transmitted from the wireless controller and wherein the base station comprises a controller for directing data to the printer or to the home gateway (Figs.1-2; Col.3, line 26- col. 4, line 27).

Regarding Claims 30-33, Treyz et al teaches the method wherein the data representative of the image in the display comprises data representative of a bar code; and further comprising the steps of monitoring use of the consumer appliance and transmitting from the consumer appliance to the hand-held wireless controller the data to be printed as a function of the monitored use of the consumer appliance; the data to be printed is targeted advertising; the data to be printed is an order confirmation (Figs.1-2,4,6, 18-19;21; 100, 107,116; Col.9, line 56- col.12, line 55; Col.15, line 3- col.16, line 55; Col.23, line 26- col.24, line 53; col. 53, line 45- col. 54, line 22; col.58, line 37- col.59, line 65).

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIJAY SHANKAR whose telephone number is 703-305-4763. The examiner can normally be reached on M-F 7:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BIPIN SHALWALA can be reached on 703-305-4938. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



VIJAY SHANKAR  
Primary Examiner  
Art Unit 2673